

*United States Court of Appeals
for the Second Circuit*



**APPELLANT'S
REPLY BRIEF**

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P/S

74-1496

In The
United States Court of Appeals
For The Second Circuit

KOPPERS COMPANY, INC., and UNIVERSAL
CORRUGATED BOX MACHINERY CORPORATION,

Plaintiffs-Appellees.

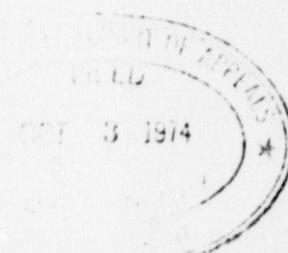
vs.

S & S CORRUGATED PAPER MACHINERY CO., INC.,

Defendant-Appellant.

REPLY BRIEF FOR DEFENDANT-APPELLANT

OSTROLENK, FABER, GERB & SOFFEN
Attorneys for Defendant-Appellant
260 Madison Avenue
New York, New York 10016
(212) 685-8470



JEROME M. BERLINER
ROBERT C. FABER
On the Brief

(7277)

LUTZ APPELLATE PRINTERS, INC
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UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

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S&S CORRUGATED PAPER MACHINERY CO., INC., :
Appellant, :
v. : Docket No. 74-1496
KOPPERS COMPANY, INC. and :
UNIVERSAL CORRUGATED BOX MACHINERY :
CORPORATION, :
Appellees. :
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DEFENDANT-APPELLANT'S REPLY BRIEF

Issues Presented for Review (Reply to K. Br., pp. 2-5)

In their purported statement of the Issues presented for review, Koppers made a number of misstatements:

In No. 1(a), Koppers suggests that the invention is directed only to straightening and pushing a pile of blanks. Koppers neglected to mention that the claimed S&S invention both aligns a stack of boxes and, more significantly, aligns panels of folded boxes before their glue joints have set in order to hold the box flaps at the correct orientation until the glue has set. A feature of the invention that Koppers did not mention is the use of the stack of folded boxes to press down on the newly stacked boxes at the bottom of the stack to hold the glued flaps of these boxes in position until the glue has set. Koppers did not mention that this is not shown in the prior art. Furthermore, despite Koppers' assertion, neither S&S nor the Examiner limited the novelty of the S&S invention to the pusher motion.

Were these features included in plaintiffs' issue No. 1, the issue would more correctly state the situation in the present case.

In No. 2, Koppers is incorrect because neither the Patent Office Examiner nor S&S ever stated that the only novelty in the patented combination lay in the vertically movable pusher plate. Only the Court below said this, and as was shown in S&S' Main Brief, the Court below was in error. In Sec. 1(c)(1), Koppers' suggests that its accused apparatus does not provide an accumulation of blanks in a stack under a moving pusher plate. However, the truth is otherwise, as described in S&S' principal Brief, pp. 44-45. In Sec. 1(c)(2), Koppers suggests that the S&S patent claim requires that the pusher plate be moving vertically while it is removing blanks from the top of the stack. But the claim does not suggest this type of simultaneous movement. The claim only requires that the blank feeding and vertical stacking operation not be discontinued during pusher movement, and this Koppers has. The support element Koppers cites in Sec. (d) is not even recited in the S&S claim, whereby its asserted absence in Koppers' unit is of no significance.

In No. 3, Sec. (a), Koppers suggests that its pusher operates so rapidly that there is no accumulation of blanks underneath the pusher as the pusher is operating. However, as shown below, Koppers has admitted the contrary. Koppers never suggested that its own box blank accumulation is other than continuous nor that box blank accumulation ever temporarily halts during pusher operation. Thus, Koppers has continuous box blank accumulation during pusher operation. With respect to Sections (b) and (c), Koppers' pusher serves to remove a top portion of the stack from the stack and to deliver that portion

to other moving means. The S&S patent claim never requires complete removal of the top of the stack by the pusher. Only at least partial removal is required in the claim. Once the top portion of the aligned stack has been moved from the stack by motion of the pusher, the claimed removal has occurred.

In No. 4, Koppers unsuccessfully attempts to show non-infringement by misinterpreting words of the claim in an effort to read the accused apparatus out of the coverage of the patent claim. To do this, Koppers purports to rely upon the doctrine of file wrapper estoppel which S&S has already shown in its principal Brief to not be applicable in the present case. But, even if file wrapper estoppel is appropriate here, the alleged limitations which Koppers attempts to read into the claim are not warranted by the claim language, by file wrapper estoppel or by patent law.

The Patent Claim in Issue is Valid (Reply to K. Br. p. 9)

As S&S emphasized in its principal Brief, the invention is directed to a novel combination whose purpose is to produce piles of folded glued boxes, wherein the glued panels of each box are all properly aligned.

As a result of non-uniformity in corrugated board, glued boxes constructed of such board are often formed with panels that are misaligned during the folding operation, or due to the springiness of the corrugated board, the glue joint may open before the glue sets. Correct panel alignment is demanded especially by packing plants having automatic equipment to erect and fill boxes.

The invention of the Shields patent in suit (PX-1, E1) is a unique unitary machine which receives individual recently glued boxes and aligns the panels of each box, holds the glue joint

closed until the glue sets and delivers piles of glued boxes.

Koppers' basic argument is that "the basic understacker of Claim 1 is old". But to prove this, Koppers first breaks the unitary invention into a number of separate elements and is then forced to look to a number of disparate references, each of which teaches a different one of the various elements of the unitary machine. By throwing these disparate references together, Koppers is finally able to argue that S&S' novel combination is known in the prior art.

Even if all of the separate elements of S&S' combination were old (and they are not as shown below), because S&S' combination is novel and, more important, because the novel combination performs functions not previously performable with the prior art, the S&S patent claim is valid. In Reiner v. I. Leon Co., 285 F.2d 501, 503 (2 Cir. 1960); cert. den., 366 U.S. 929 (1961), the Court said:

"* * * It is idle to say that combinations of old elements cannot be inventions; substantially every invention is for such a 'combination': that is to say, it consists of former elements in a new assemblage. All the constituents may be old, if their new concourse would not 'have been obvious at the time the invention was made to a person having ordinary skill in the art' (Sec. 103, Title 35)."

Otto v. Koppers Co., 246 F.2d 789, 800 (4 Cir. 1957); cert. den., 355 U.S. 939 (1958); Reeves Instr. Corp. v. Beckman Instr., Inc., 444 F.2d 263 270-71 (9 Cir. 1971); cert. den., 404 U.S. 951 (1971).

The Absence of any Prior Art that Shows More than a Minor Detail of the Patent Combination Proves the Invention was Non-Obvious (Reply to K. Br. p. 18)

Because of the absence of relevant prior art bearing on S&S'

patented combination, Koppers has dissected the combination into individual elements and has considered each of the elements standing alone in terms of the prior art, but failed to give consideration to the combination in its entirety.

The deficiencies of the prior art patents are discussed in the S&S main Brief at pages 6 through 8, 26 and 27. The Koppers Brief fails to refer to any objective factors, since there are none, showing that it would have been obvious to combine individual features of the prior art to arrive at the clearly novel combination of Claim 1 defining apparatus which produces surprising and unexpected results.

P. 24 of Koppers' Brief suggests that because there are structures analogous to individual elements of the invention in various references in the material handling art, S&S' unitary construction is taught by an assemblage of these references. Because Koppers relies upon and combines so excessive a quantity of references, each showing a minute portion of the entire invention, this shows S&S' unitary invention to be non-obvious and patentable.

If the invention were so obvious a development, there should have been one reference that shows virtually the entire combination from which the invention would be an obvious modification. But plaintiffs have not presented such a reference.

There is nothing to suggest that in the box blank handling art where you are attempting to align the panels of a glued box, that any of the various references of record are intended to be combined, or that a mechanic skilled in the art would even think of combining them to bring about the improved results which S&S has achieved.

Koppers suggests at K. Br. p. 25 that all that S&S has done is to add two and two together to get four. Based upon the prior art found by Koppers, it seems more correct to say that in its vain attempt to show that S&S' patented invention is obvious, has added 1/4, 1/2, 1/8, 1/4, 1/2, etc., finally claiming Koppers has reached the four it is striving so hard to reach. Nonobviousness in the face of so many references becomes clear. See Ling-Temco-Vought, Inc. v. Kollsman Instr. Corp., 372 F.2d 263, 268-69 (2 Cir. 1967).

Finally, none of the references suggests so combining the features of patent Claim 1 for providing an efficient apparatus to receive individual newly-glued box blanks, some of which have misaligned panels and to deliver a pile of boxes in which the glue joints are set and the panels properly aligned, wherein the stack itself serves as one of the mechanical elements to hold the joint elements in place until the glue has set.

Claim 1 is clearly valid as being nonobvious under 35 U.S.C., Sec. 103.

The Court in Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Corp., 340 U.S. 147, 152 (1950), stated that a combination can be patentable:

"The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable."

This holding in A&P was echoed in Anderson's - Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 61 (1969), wherein the Court stated:

"A combination of elements may results in an effect greater than the sum of the several effects taken separately. No such synergistic result is argued here."

The synergism of a combination, missing in Anderson's was found in Illinois Tool Works, Inc. v. Sweetheart Plastics, Inc., 436 F.2d 1180, 1187 (7 Cir. 1971); cert. dism., 403 U.S. 942 (1971); Van Gorp Mfg., Inc. v. Townley Indust. Plastics, Inc., 464 F.2d 16, 21 (5 Cir. 1972); Cavitron Corp. v. Ultrasonic Research Corp., 301 F. Supp. 293, 303 (S.D. Fla. 1969); affd., 426 F.2d 295 (5 Cir. 1970).

Even before Anderson's, where a combination of elements produced something that was greater than the sum of its parts, the patent on the combination was held valid. Ling-Temco-Vought, Inc. v. Kollsman Instr. Corp., 372 F.2d 263, 268 (2 Cir. 1967); Continental Can Co. v. Old Dominion Box Co., 393 F.2d 321, 326 (2 Cir. 1968).

S&S' combination, and the benefits provided thereby were never envisioned in the prior art. The whole of the present invention of suit patent Claim 1 is greater than the sum of all of its parts. As suggested by Koppers, the patented invention includes a conveyor, a slapper and a pusher. You would not expect that this array of elements would be able to receive individual boxes having tacky glue joints and folded panels that might be misaligned, would properly align all the panels, would cause all the glue joints to set properly in fully closed condition without any of them springing open (this results from the presence of a stack of boxes above each box and the weight of the stack holds the glue joint closed), and then would deliver a neatly stacked group of boxes all having their respective panels properly aligned. You would also not expect that box panel straightening could be occurring while a stack of boxes is rising in an underfed stack, and that a pusher could

move a pile of boxes from the top of the stack without interrupting infeeding at the bottom of the stack, that the underfed stack of boxes would serve as an element to prevent the glue joints from opening until the glue sets properly and also prevent the panels that have been slapped from springing back to misalignment, and that such machine would result in a saving of manpower and a great saving in space as compared with the most pertinent prior art. You would not expect these benefits, but in the Shields invention the whole is greater than the sum of its parts. See United States v. Adams, 383 U.S. 39, 51 (1966):

"We conclude the Adams battery was also nonobvious. As we have seen, the operating characteristics of the Adams battery have been shown to have been unexpected and to have far surpassed then-existing wet batteries."

Even if the elements of an invention are each known, if in view of the pertinent prior art the asserted invention is a significant improvement over the prior art and operates more efficiently and better and, most important, is nonobvious, then a patentable invention is present. Shaw v. E.B. & A.C. Whiting Co., 417 F.2d 1097, 1101 (2 Cir. 1969); cert. den., 398 U.S. 954 (1970); Frank W. Egan & Co. v. Modern Plastic Mach. Corp., 387 F.2d 319, 320, 323 (3 Cir. 1967); cert. den., 391 U.S. 966 (1968); McCullough Tool Co. v. Well Surveys, Inc., 343 F.2d 381, 393 (10 Cir. 1965); cert. den., 383 U.S. 933 (1966). To anticipate a combination of elements, it is necessary to find that combination in the art. Lawrence v. Hunt Tool Co., 142 F. Supp. 329, 334 (S.D. Tex. 1956); modified on other grounds, 242 F.2d 347 (5 Cir. 1957); cert. den., 354 U.S. 910 (1957). S&S' combination cannot be found in the art.

The Level of Ordinary Skill in the Art was Such that the Present Invention would have been Non-Obvious (Reply to K. Br., p. 26)

The invention lies not in the recognition that conveyors convey, slappers slap, etc., but that the arrangement of conveyor, slapper, etc. would provide a combination that was markedly superior to previous arrangements for solving the problem. General knowledge concerning the principles of engineering and the principles of material handling would not result in the apparatus of the invention. The Spiess reference (App. E, Ref. 16) was the way that persons skilled in the art had handled the basic problem solved by the invention. General knowledge only resulted in the much less efficient apparatus of Spiess which was the best that the art had been able to come up with. A totally unobvious solution to this problem was developed by Shields, whose educational attainments and experience far exceeded those of anyone else referred to in the trial record. The Shields solution led to the present invention and the combination recited in Claim 1 of the suit patent. See United States v. Adams, 383 U.S. 39, 51 (1966); Ling-Temco-Vought, Inc. v. Kollsman Instr. Corp., 372 F.2d 263, 268 (2 Cir. 1967). Hence, the present invention was not an item which somebody with ordinary skill in the pertinent art would have devised.

The Remarkable Commercial Success of S&S' Invention Buttresses its Patentability (Reply to K. Br., p. 29)

The remarkable commercial success of S&S' invention is discussed at S&S' Main Brief, pp. 30-32.

Of course, there was a long-felt but unresolved need for the claimed subject matter. See Frank W. Egan & Co. v. Modern Plastic Mach. Corp., 387 F.2d 319, 324 (3 Cir. 1967); cert. den., 391 U.S. 966 (1968). The best the prior art had come up with was the inefficient Spiess apparatus (see S&S' Main Brief, pp. 6-8). Note the remarkable

benefits of the present invention over Spiess. To show that the need in the industry was long felt, the application for the Spiess patent was filed in October 1950, more than six years before the application for the suit patent. Since the development of the invention covered in the suit patent, S&S' construction has replaced the Spiess construction as the box-handling construction of choice, as shown not only by S&S' significant commercial success, but also by Koppers' choosing to copy defendant's successful apparatus. Accord, Stuart W. Johnson & Co. v. Ro-Ber, Inc., 156 USPQ 177, 182 (N.D. Ill. 1967); Reeves Instr. Corp. v. Beckman Instr., Inc., 161 USPQ 450, 480 (Conclu. 16) (C.D. Calif. 1968); affd., 444 F.2d 263 (9 Cir. 1971); cert. den., 404 U.S. 951 (1971). Koppers appears to have a history of such copying. Otto v. Koppers Co., 246 F.2d 789, 800 (4 Cir. 1957); cert. den., 355 U.S. 939 (1958).

Koppers declares, incorrectly, that the testimony fails to show that S&S' devices fall within Claim 1 of the suit patent. But the contrary is shown in the testimony of Lehman at 450-5a. Furthermore, Koppers' own remarkable commercial success with its infringing underfeed stacker-straighteners is described at 531-2a. See Stuart W. Johnson & Co. v. Ro-Ber, Inc., 156 USPQ 177, 182 (N.D. Ill. 1967); Otto v. Koppers Co., 246 F.2d 789, 800 (4 Cir. 1957); cert. den., 355 U.S. 939 (1958). These machines do not include a spiral lift feature and were made in accordance with the patent.

At the end of page 30 of its Brief, Koppers sneaks in a charge that S&S tried to tie its sales of patented stacker-straighteners with sales of its large folder-gluers. This assertion is untrue. As shown in the testimony of Flaum (PX-34, pp. 27, 32, 33) and Shields (DX-12, pp. 91-2), S&S stacker-straighteners were engineered

for the S&S folder-gluer and total S&S production of stacker-straighteners was required for its folder-gluers. There was a two year backlog and S&S could not meet its delivery commitments. At that time, it would have been ridiculous for S&S to sell stacker-straighteners separately, and thereby further increase its backlog and its inability to supply complete stacker-straightener, folder-gluer units to customers who ordered the combination.

Commercial success does not cure the absence of patentability. But the net effect of the evidence in this case shows that patentability is present. What the commercial success, including Koppers' own use of the patented device for a period of time shows is that there was a long felt need - a hunger - for the invention and the invention made an important contribution to the corrugated box handling art.

The Uncited Prior Art is So Different From the S&S Invention and is Related Only to Individual Features of the Combination, Buttressing the Presumption of Validity of the Claim (Reply to K.Br.p. 32)

Koppers cited Spiess (PX-2, Tab 16) to weaken the presumption of validity. It is submitted that the presumption has been strengthened, not weakened, because Spiess, although being the only prior art showing a device for handling glued boxes before setting of the glue joints, is a very inadequate reference, as detailed in S&S' main Brief, pp. 6-8, and shows how radically the Shields invention departs from the prior art.

Crank and Kottmann, both in remote arts, were cited merely to show slidable pusher plates. This also is not significant previously uncited prior art which affects the validity of the patent.

Spiess' right angle stacker is so different from the invention that there was no reason for S&S to bring it to the attention of

the Patent Office since Spiess was irrelevant in concept and in structure to the invention. The Spiess top fed right angle machine with a separate top fed counter takeoff does not remotely suggest the Shields invention of box panel straightening in an underfed stack having an in-line takeoff directly from the top of the same underfed stack in which panel straightening takes place. Spiess was relevant as an example of the state of the prior art, but Spiess was not pertinent art whose absence from the prosecution in the Patent Office of the patent in suit affected the patentability of the claims in any way.

The presumption of validity remains strong, as discussed in S&S' main Brief at pp. 34-36, Cf. Tapco Prod. Co. v. Van Mark Prod. Co., 446 F.2d, 420, 425 (6 Cir. 1971); cert. den., 404 U.S. 986 (1971).

The Court Below Did Not Apply the Standards Set Forth in the Graham Case and Did Not Make Findings Necessary For Determining the Validity of S&S's Patent (Reply to K.Br.p. 33)

The Court below, noted the Graham test and then proceeded to apply the wrong test. Note the material from pp. 16-23 of S&S' main Brief which indicates why the Court decided what it did and pp. 23-24 showing that the Court failed to meet the Graham test. At 614a, the Court might have had the opportunity to study the prior art references, but it certainly did not discuss them. It only mentioned those references that relate to pushers. This is not the discussion in detail which Koppers asserts occurred, and is not the discussion of the prior art required by Graham.

As noted in S&S' main Brief, the Court did not make any inquiry as to the level of ordinary skill in the art, other than simply asserting that it was "high".

After making the wrong test, it would be expected that the Court below would reach the wrong conclusion (615a), quoted on p. 34 of Koppers' Brief. What the Court below found was not that S&S' patent combination was invalid, but rather that the pusher mechanism, which was not S&S' invention, was not new. Finding that something that was not the invention was not new at the time the invention was made is not the same as Graham finding that the entire inventive combination was not patentable.

The Court Below Did Not Properly Apply the Appropriate Test for Invalidating the S&S Combination (Reply to K.Br. p 34)

The argument made by Koppers and this heading has previously been dealt with, ante. pp. 4-8. Under the appropriate circumstances, there is invention in a combination of elements. Cf. United States v. Adams, 383 U.S. 39, 50, 51 (1966).

What the Court held in A&P appears at 340 U.S., p. 152:

"The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable."

Anderson's - Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 61 (1969):

"A combination of elements may result in an effect greater than the sum of the several effects taken separately."

Illinois Tool Works, Inc. v. Sweetheart Plastics, Inc., 436 F.2d 1180, 1187 (7 Cir. 1971); cert. dism., 403 U.S. 942 (1971); Van Gorp!fg., Inc. v. Townley Indust. Plastics, Inc., 464 F.2d 16, 21 (5 Cir. 1972).

Combination patents have often been held valid in the Second

Circuit: Ling-Temco-Vought, Inc. v. Kollsman Instr. Corp., 372 F.2d 263 (2 Cir. 1967); Norman v. Lawrence, 285 F.2d 505 (2 Cir. 1960); Reiner v. I. Leon Co., 285 F.2d 501 (2 Cir. 1960); cert. den., 366 U.S. 929 (1961).

Koppers has Misapplied the Doctrine of File Wrapper Estoppel (Reply to K. Br., p. 37)

Purporting to support its interpretation of the law of file wrapper estoppel, Koppers' Brief, pp. 37-38 contains passages from International Latex Corp. v. Warner Brothers, and I.T.S. Rubber Co. v. Essex Rubber Co. However, in these cases, the basis of the estoppel was that claim amendments were made to avoid the prior art and that the claims avoided the prior art merely because of the amendment in question. Koppers' interpretation of file wrapper estoppel is not applicable to the prosecution of the Shields patent (PX-1), where the language in question was not added to avoid the prior art. See S&S' Main Brief, pp. 17-19 and 19-22.

The Prosecution History of the Patent in Suit Shows that the Claim in Issue Cannot be Limited Under the Doctrine of File Wrapper Estoppel (Reply to K. Br., p. 38)

Koppers' Brief completely ignores the substance of the Office Actions in the Shields application and the actions which S&S took in response thereto. Although there were four Office Actions, Claim 1 was rejected over prior art in only two of them. (See S&S' Main Brief, pp. 18-19). No amendments were made to the claims by S&S as a result of the prior art rejections. In reply to the two prior art rejections, S&S only submitted argumentation, and the argumentation was obviously persuasive, because both rejections were withdrawn by the Examiner. Koppers suggests that Claim 1 was "severely limited"

as a result of the rejections and that S&S' claim amendments were made "in order to add novelty and avoid prior art". However, as shown in the discussion in S&S' Brief, at pp. 21-22, such limitations as were added to Claim 1 by S&S were not severe limitations but were rather minor amendments to overcome objections, not as to prior art, but as to mere formalities of language. File wrapper estoppel cannot be read into a situation where there were no amendments made to avoid prior art.

It is the Examiner's non-binding dictum in the fourth Patent Office Action (PX-19, E 68), which Koppers seizes upon as proof that amendments were made by S&S to the claim to avoid prior art. However, a reading of that Office Action shows that prior art avoidance was not the purpose of the amendments made in response to that Office Action. In the second and third Office Actions, prior art was cited and claims were rejected over that prior art. Had amendments been made by S&S in response to those rejections, and none were made, those amendments would have been made to avoid the prior art.

In the fourth Office Action, the Examiner issues an uncalled for dictum, namely that he thinks the novelty lies in one particular feature. However, this dictum is not coupled with any rejection over prior art. Nothing suggests that in the event the claim is not modified to avoid any prior art, the claim will not be allowed. The Examiner's dictum is not pertinent to the actual rejection which he issued, which was one on the alleged indefiniteness of the claim. Since there was no prior art rejection and no rejection for lack of novelty, the applicant did not amend to avoid prior art and did not amend to add novelty. There was no reason to amend to avoid a non-binding dictum not based on any prior art and, therefore, the applicant's amendment cannot be

misconstrued, as Koppers wishes it to be, as an amendment to avoid prior art.

One of the most basic errors of the Court below was to elevate this minor formal amendment, which was made only to improve the definiteness of the claim, into being the only novel feature of the claim. As was pointed out earlier herein, the claim is directed to an entire combination and merely because one passage of the claim was amended to make it more "definite", that passage does not become the only scope of patent protection accorded the claim in suit. It is the entire combination that was and is patentable.

The three changes noted by Koppers at p. 40 of its Brief were all made in response to the request from the Examiner that the claim be amended, not to avoid any prior art, but only to make the language clearer and more definite. Sure, S&S noted that the amendment as to the pusher is not shown in the prior art. But this statement by S&S was not made in response to a prior art rejection. It was merely the icing on the cake, the statement made at the conclusion of a matter, without any necessity for or significance to that remark in terms of responding to a rejection. Koppers is attempting to elevate a throw away statement into a serious admission when the context in which the statement was made shows it to be otherwise.

Furthermore, remarks by counsel during prosecution of an application are not pertinent with respect to file wrapper estoppel. (See S&S' Main Brief, pp. 22-23)

As S&S did not amend its claim to avoid prior art, S&S gave up nothing of its right to claim infringement. It certainly did not give up the right to assert infringement as to the features noted in Koppers' Brief at pp. 40-41.

Claim 1 is Infringed Because the Pusher Plate Feature of Koppers Combination Falls Within the S&S Patent Claim (Reply to K. Br. p. 41)

The pertinent language in the S&S patent claim as to this feature is:

"...said pusher plate being mounted for limited vertical movement relative to the means for supporting the pusher plate, said stack being fed with blanks as the movable plate is removing said top portion from the stack."

Koppers asserts that this section requires that a plurality of blanks accumulate under the pusher while the pusher is moving. But, the claim only requires that the procedure of feeding blanks continue while the pusher is operating. This is to be distinguished from the situation where feeding into a stack temporarily halts during removal operations, as the prior art had taught. It is irrelevant whether during every stroke of the pusher two blanks are fed, only one blank is fed or for that matter, even no blanks are fed.

Koppers further asserts that the claim requires that the pusher move relatively slowly. However, nowhere in the claim is there any discussion of pusher speed as this is not pertinent to the claimed invention.

At pp. 41-42 of its Brief, Koppers erroneously contends that Claim 1 specifies that limited vertical movement of the pusher plate must take place as the stack is being fed with blanks and as the pusher plate is removing the top portion of the stack. However, with respect to vertical movement of the pusher plate, the limitation of Claim 1 is only permissive, stating:

"...said pusher plate being mounted for limited vertical movement relative to the means for supporting the pusher plate."

Nothing in Claim 1 specifies either when the limited vertical movement of the pusher plate takes place, or the means for causing this limited vertical movement. There is no doubt that the pusher plate of Koppers' first model (PX-3) is mounted for limited upward movement and there is no doubt that in Koppers' later models of PX-5 and PX-12 the pusher plates are positively raised at the ends of their forward strokes. Even though the pusher plates of the PX-5 and PX-12 models rise by moving about a pivot center, this pivoting movement is so confined as to cause the pusher plate movement to in fact be the "limited vertical movement" called for in Claim 1.

The wording of Claim 1 is such that the last limitation thereof:

"said stack being fed with blanks as the movable plate is removing said top portion from the stack",

does not impose limitations that require the vertical movement of the pusher plate to result from the infeeding of blanks to the stack.

Of course, the applicant's specification does note that a pusher may rise to account for the rising stack of blanks. However, remember that this discussion in the specification is of one preferred embodiment of the invention, and an applicant's claims are not limited by the one preferred embodiment of the invention which the applicant includes in his specification, as required by 35 U.S.C. Sec. 112. (See S&S' Main Brief, pp. 46-47).

At pp. 41-42 of its Brief, Koppers also falls into the error of trying to show non-infringement by comparing an actual S&S machine with a Koppers machine. However, as was pointed out in S&S' Main Brief, p. 37, the test for infringement is not a comparison between S&S' and Koppers' machines, but between the S&S patent claim and Koppers' machine. When the correct comparison is made, infringement is apparent.

In an effort to show non-infringement, Koppers asserts that the evidence at trial showed there was no accumulation of blanks under movement of its pusher and that its pusher did not move vertically (K. Br. p. 42). But the evidence discussed at S&S' Main Brief, p. 45 shows the contrary of what Koppers says to be correct.

Referring to Koppers' Brief at pp. 42-44, there appears to be a denial that the accused devices are capable of infeeding at the bottom of the stack when the top of the stack is being removed. The sole evidence offered by Koppers in connection with this point are naked statements by Koppers' witnesses to the effect that there were no blanks fed into the stack of Koppers' devices during the pushing stroke. Considering the apparent painstaking manner in which Koppers' case was prepared and presented, logic dictates that if the accused devices, or any of them, were actually constructed so as to prevent infeeding during takeoff, Koppers would have demonstrated their precise construction showing that. The record is barren of any such showing, and Koppers' expert Fischer admitted that infeeding could occur during takeoff (309a). In connection with operation of the accused devices, infeeding during takeoff is shown in the enlarged five-frame sequence (DX-E1-E5) taken from film DX-D (E 128-32) and this condition was observed by the witness Cantor at the Time Container plant in Monroe, Michigan (536a) and he took still photographs (DX-U, UA, UB, E-133-34) at Hankins in Union, New Jersey, to indicate this condition.

Cantor's testimony responding to questioning at 582a does not support Koppers' conclusion 'that Claim 1 requires 'plural blanks' to be fed underneath the pusher" during each pushing stroke thereof. The line of questioning at this point was directed solely to Figure

1 of the patent drawings and the description thereof and was not directed to the wording of the patent claims. The question and answer relied on by Koppers is garbled in that the question is prefaced by reference to the patent drawings ("In fact I can talk about figure 1 of the patent."), and then for some unexplained reason the transcript switches terminology very abruptly and the question is not understandable ("This patent through the claims that there are ***?). Confusion in this area is highlighted by the declaration of the witness: "I'm sorry, I don't understand that question now." The ground intended to be covered by the line of questioning at 582a was gone through again immediately (583a), and in this rerun there is no support whatsoever for Cantor's alleged admission.

Koppers' argument on this point is in part based upon Koppers' assumption that the vertical movement of the pusher plate must occur simultaneously with the delivery of a blank to the stack.

The Motion of Koppers' Slapper Falls Within the Suit Patent Claim (Reply to K. Br., p. 44)

Koppers' argument that the motion of its slapper does not fall within the suit patent claim is premised on the amendment which S&S made, substituting "reciprocally" for "oscillatorily". As was discussed above, this change was made not, as Koppers asserts, to avoid prior art, because no prior art was asserted against the claim when this amendment was made, but at the suggestion of the Examiner only to make the claim language more definite, by substitution of a better word for the equivalent operation. Somehow, Koppers has decided that the change from "oscillatorily" to "reciprocally" excludes Koppers' accused device pivoting motion from the term "reciprocally", even though the significant motion of the Koppers slapper is a reciprocating motion

in a longitudinal direction, as called for in Claim 1.

Koppers' Pusher Plate is Mounted for Limited Vertical Movement Relative to the Means for Supporting it and Thereby This Limitation of the Suit Patent Claim is Met (Reply to K. Br. p. 45)

S&S is entitled to the full range of the structures which fall within the language of its claim. Claim 1 may be infringed even by devices that do not have a bicycle chain to support a pusher or a pusher plate that slides vertically. The language of Claim 1 in this connection, "...means for supporting the said pusher plate..." and "said pusher plate being mounted for limited vertical movement" is much broader than the interpretations urged by Koppers. Cantor's testimony concerning the use of stop surfaces for vertically positioning Koppers' pushers of PX-5 and 12 (567-69a) during pushoff was not controverted by any of Koppers' witnesses. These stop surfaces meet fully the "means for supporting" limitation of Claim 1 even if a power cylinder is interposed between the pusher plate and stop surfaces. Within the context of the suit patent, the stop surfaces and upward movement of the pusher plates in Koppers' devices PX-5 and 12 satisfy the claim terminology concerning "means for supporting" and "mounted for limited vertical movement", and are equivalents of the elements in the Shields patent (PX-1) that provide the basis for these limitations (519-22a).

As to the inapplicability of file wrapper estoppel here, this has been previously dealt with, ante, pp. 14-16.

That Koppers may not use a chain to support its pusher plate and may use another supporting means, still means that Koppers has some "means for supporting the said pusher plate" in its structure. Even as to those Koppers units where sliding does not occur, since the pusher plate has limited vertical movement, regardless of whether

that movement be by sliding or otherwise, the limitation "said pusher plate being mounted for limited vertical movement" is met.

The Svenska citation noted by Koppers says that each "essential" element of a combination must be present in the accused device. With Koppers' accused device, each essential element is present. A bicycle chain is not essential; it is not claimed. Sliding motion of the pusher plate is not essential; it is not claimed.

Claim 1 Defining Shields' Meritorious Invention
is not Limited to Precise Element Forms Illus-
trated in the Suit Patent

From a study of the prior art, there is no doubt that Shields was the first to invent an underfed stacker-straightener with in-line delivery that receives boxes from a folder-gluer while the glue joints are still tacky, straightens misaligned box panels while the boxes rise in the stack, and takes piles of completed boxes directly from the top of the stack. It is submitted that the quoted passage from the Svenska v. Mergenthaler case at p. 47 of Koppers' Brief is not relevant, since each essential element of Shields' Claim 1 is found in each of the accused devices. The opinion Beauchamp v. Schireson, 18 F. Supp. 367, 371-72 (S.D. Cal. 1937) is highly instructive in connection with the interpretation of a claim directed to a combination of mechanical elements by not limiting unnecessarily the form of one element. The only differences between each of the accused devices and the device illustrated in the Shields patent (PX-1) concern minor variations in structural forms which nevertheless are embraced by the language of Claim 1. These variations do not, under the controlling decisions, avoid infringement of Claim 1. Graver Mfg. Co. v. Linde Co., 339 U.S. 605, 607 (1950).

Claim 1 of the Shields patent in suit (PX-1) reads directly on each of Koppers' three accused devices (illustrated in PX-3, 5 and 12). Those changes of mechanical form that may be present were introduced by Koppers "to conceal and shelter the piracy" (Graver at p. 607).

The Doctrine of Equivalents as it Applies to the Present Case Mandates a Finding of Infringement (Reply to K. Br., p. 48)

The language of the claim itself determines the scope of the invention. The specification and drawing are only exemplary and do not determine the scope of the invention. Maxon v. Maxon Constr. Co., 395 F.2d 330, 334-35 (6 Cir. 1968); Kearney & Trecker Corp. v. Giddings & Lewis, Inc., 306 F. Supp. 189, 193 (E.D. Wis. 1969); reversed on other grounds, 452 F.2d 579 (7 Cir. 1971); cert. den., 92 S.Ct. 1500 (1972); Reeves Instr. Corp. v. Beckman Instr., Inc., 444 F.2d 263, 274 (9 Cir. 1971); cert. den., 404 U.S. 951 (1971). The specification and drawings provide a non-limiting example of the invention. Eastern Elec., Inc. v. Seeburg Corp., 310 F. Supp. 1126, 1132 (S.D.N.Y. 1969); affd., 427 F.2d 23 (2 Cir. 1970). In the present case, the language of the claim can be easily understood, as clearly shown in the detailed review of the claim in S&S' Main Brief, pp. 9-11. The non-limiting example in the specification does not narrow the scope of the claim.

Koppers suggests that S&S may not resort to the Doctrine of Equivalents because S&S' invention is "narrow". But, Koppers' assertion of narrowness is not backed up by evidence or argument. As was shown in the discussion of the validity of the patent claim in suit, no one reference teaches the combination, and even a combination of all of the references does not suggest the combination of the present invention.

The best the prior art has to offer is Spiess (PX-2, Tab. 16), and Spiess is the only prior art directed to apparatus for receiving and operating on glued boxes while their joints are still tacky. As discussed in detail in S&S' Main Brief, pp. 8-9, the Shields invention is distinguishable from Spiess. These large differences in concept, construction and operation between Spiess and the present invention clearly shows that the Shields invention is broad and significant. None of the other references suggest the novel combination of features which the applicant has clearly recited in Claim 1, and unless the entire concept of the Spiess machine is abandoned, there is no way of using prior art teachings to modify Spiess in a manner even suggesting the Shields invention. The mere recitation of one of defendant's claimed features, with respect to a machine unrelated to the present invention, cannot be seriously used as a basis for narrowing the scope of the invention which covers a combination. All of the discussion with respect to the Doctrine of Equivalents and the right of the patentee to include equivalents in the scope of its claims is based upon plaintiffs' unfounded assumption that the patented invention is narrow.

Considering that the only relevant reference in the field of glued box handling which the plaintiffs could find was Spiess, it would be specious to state that the relevant field of art was crowded when, in fact, there is virtually no really relevant prior art and there is art only as to separate details, but no art to suggest that the unrelated art should be combined to show the invention.

The Shields patent PX-1 is to a combination which constitutes a marked improvement and should be interpreted broadly. Eibel Co. v. Paper Co., 261 U.S. 45, 63 (1923).

McCullough Tool Co. v. Well Surveys, Inc., 343 F.2d 381,

401 (10 Cir. 1965).

Koppers' accused apparatus obtains the same result as falls within the scope of and functions in the same manner as the structure claimed in the S&S patent claim.

The "Means" Limitations in the Suit Patent Claim Are Broad in Scope, Not Limited to the Precise Disclosure of the Specification and Drawings
(Reply to K. Br., p.51)

Koppers' attempt to limit the 'means' limitation of the S&S suit patent claim to the precise means disclosed in the specification and drawings flies directly in the face of the statute permitting use of "means" limitations, viz. the third paragraph of 35 U.S.C., Sec. 112, which says that:

"An element in a claim for a combination ... [that is] expressed as a means or step for performing a specified function ... shall be construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof" (Emphasis supplied)

This applies to claim infringement. See the authorized Commentary on the then new Patent Act, 35 U.S.C.A., p. 1, 26.

In Application of Sweet, 157 USPQ 495, 499, 393 F. 2d 837, 341-42 (CCPA 1968), the Court of Customs and Patent Appeals, which hears appeals from the Patent Office and is therefore continuously involved with patent law, said:

"However, a recitation of "means" for performing a function is interpreted broadly to cover all means capable of performing the stated function and is not limited to the particular structure which the application may disclose."

Ex Parte Birnbaum, 161 USPQ 635, 637-38 (Pat. Off. Bd. of App. 1968); Bryan v. Sid W. Richardson, Inc., 117 USPQ 157, 159-60, 254 F. 2d 191, 194-95 (5 Cir. 1958); cert. den., 358 U.S. 815 (1958). See Stearns v. Tinker and Rasor, 252 F. 2d 589, 597-98 (9 Cir. 1957); cert. den., 350 U.S. 830 (1957). The S&S "means for supporting the pusher plate" is not limited to a bicycle chain, but covers any means that provides such support as the claim recites.

Those precedents to which Koppers refers in support of its novel, unsupported proposition of law, are not properly applicable.

Koppers attempts to mislead this Court by only quoting a short passage from Hazeltine Research, Inc. v. Firestone Tire & Rubber Co., 468 F. 2d 1277, 1279 (4 Cir. 1972). The Court defines why it said what Koppers quoted it as saying. The patent in question only made a very small advance in the existing art and could only be given narrow scope. Were it to be given broader scope, it would be invalid over prior art. Thus, confining the scope of the patentee's "means" preserved the validity of the claim. S&S, on the other hand, has made a significant, not limited, improvement, and narrowing the scope of S&S' claims is not necessary to save its validity. Finally, S&S is not seeking to preempt every conceivable means. Instead, S&S claims particular, limited means, that supporting the pusher plate in a manner that enables it to remain in a vertical position while it contacts the blank stack. Hence, Hazeltine is not an appropriate citation.

In Del Francia v. Stanthony Corp., 278 F. 2d 745, 748 (9 Cir. 1960), the Court erred in relying upon two cases decided in the 1930's. Paragraph 3 of Section 112 was added in 1952 and this statutory provision expressly overruled the prior law (See the aforesaid Commentary, 35 U.S.C.A., p. 25, final paragraph). The Stearns case, cited by the Court in Del Francia, supports S&S's interpretation.

Cincinnati Milling Mach. Co. v. Turchan, 208 F. 2d 222, 225 (6 Cir. 1953) also relies upon precedents that have been overruled by 35 U.S.C., Sec. 112. Also, it was decided shortly after the 1952 enactment of 35 U.S.C., Sec. 112. Therefore, the case arose under the prior law which did not include provision for 'means' clauses.

Graphicana Corp. v. Baia Corp., 472 F. 2d 1202, 1203-04 (6 Cir. 1972) is an example of what happens when a court relies only upon its own precedents, without noting subsequent changes in the law. In holding that the word "means" is more limited than 35 U.S.C., Sec. 112 says it is, the Court in Graphicana relied upon precedents which are out of date, including the Cincinnati case discredited herein.

The Hazeltine Research case next noted by Koppers is a repetition of the case first mentioned by them.

In Western States Mach. Co. v. S.S. Hepworth Co., 147 F. 2d 345, 351 (2 Cir. 1945), the Judge Learned Hand stated what

may have been good law in 1945. But the 1952 enactment of 35 U.S.C., Sec. 112 changed all that prior law and makes Judge Hand's statement anachronistic.

In light of the present version of 35 U.S.C., Sec. 112, the precedents interpreting that statute and the inapplicability of the precedents relied upon by Koppers, S&S clearly is permitted to expand its claimed means for supporting the pusher plate beyond that shown in the specification and drawings, and is certainly able to draw within the scope of that language the similar in result, structure and function plate support means of the Koppers accused apparatus.

There is Identity of Structure, Function and Operational Means Between the Claimed Subject Matter, Including its Equivalents and the Koppers Accused Devices (Reply to K. Br. p. 53)

Koppers suggests that S&S' advance over the prior art is a small one in a crowded art. But, as has been shown above, the advance was a large and significant advance in a most uncrowded art.

All of the six alleged differences between the Koppers accused devices and the S&S claim turn out to be no differences at all when the S&S claim is reviewed in terms of the Koppers accused device.

(1) Koppers' Pusher Plate Falls Within the Claim (Reply to K. Br. p. 55)

The relevant limitation of Claim 1 is:

"... a longitudinally movable plate for periodically pushing a top portion of the stack of said blanks from said accumulating device".

"..., all of Plaintiffs' understackers ... have a ... pusher plate ... that ... displaces the top portion of the stack" (K. Br. pp. 55-56). Thus, admittedly, each of the accused devices has a "pusher plate" which moves a top portion of the stack. This movement of the top portion is not in line with the stack, it is not into the stack, but is away "from" the stack just as called for in Claim 1.

Plaintiffs point out that in each of the accused devices the pusher plate by itself does not effect total removal. However, Plaintiffs fail to note that the pusher plate must push the pile "from" the stack or there will not be any delivery. Admittedly, the exemplary device illustrated in the disclosure of the Shields patent PX-1 shows a pusher that moves across the entire length of the stack, but Claim 1 is not limited to such mode of pusher operation, and there is no legal justification for imputing such a limitation to Claim 1. Even slight movement of the pusher falls within the claim, so long as it cooperates in pushing a portion of the stack.

Even if the Gjostein patent (PX-2, Tab 23) showed a structure identical in form and operation to Koppers' pusher plate, this does not establish that the limitation in question is not met, and would certainly not establish lack of infringement when the combination of Claim 1 is considered in its entirety.

In addition to the Koppers pusher falling within the S&S patent claim 1, the pusher has a 5 inch stroke and there are vertical side rollers. The presence of these additional features in the Koppers structure does not lift its infringing apparatus out of the S&S claim ambit.

- (2) The S&S Claim does not Require A Bicycle Chain for Supporting the Pusher Plate and Any Pusher Plate Support Means Having the Claimed Characteristic Infringes (Reply to K. Br. p. 57)

The relevant limitation of Claim 1 is:

"...means for supporting the said pusher plate so that it remains in a substantially vertical position when in contact with the said blank stack,...".

There is no doubt that when the "pusher plate" of each accused device is "in contact with said blank stack" such "pusher plate" is "in a substantially vertical position". Thus, each of the accused devices must have some "means for supporting" the pusher plate in this vertical position, and it is this "means" that meets precisely the limitation in Claim 1 of "means for supporting the said pusher plate".

This "means for supporting" is not the sole limitation distinguishing the combination of Claim 1 from the prior art so that there is no legal basis for limiting the "means for supporting" of Claim 1 to the exemplary chain arrangement illustrated in the Shields patent (PX-1). The plate of the accused device shown in PX-3 which slidably supports the pusher plate meets the "supporting means" limitation of Claim 1 just as do the support formations on the frame (520-22a) which limit downward pivoting of the power cylinder, support the pusher plates in the accused devices shown in PX-5 and PX-12 in vertical positions when contacting the stack during push-off.

A claim is not limited to the embodiment in the specification and drawings, as 35 U.S.C., Sec. 112 permits equivalents.

- (3) The Koppers Pusher Operates "Periodically as Required by Claim 1 (Reply to K. Pr. p. 59)

The relevant limitation is:

"...a longitudinally movable plate for periodically pushing a top portion of the stack of said blanks from said accumulating device...".

Koppers improperly asserts as a fact that the "pusher plate of Claim 1 must be 'periodically' operated" (K. Br. p. 59) when the limitation states merely that "pushing" by the pusher plate be done periodically, rather than continuously. Even though the pusher plate illustrated in the Shields patent (PX-1) moves continuously, it pushes periodically, not continuously. Similarly, the pusher plate of each accused device does not push continuously, but periodically. There are intervals between pushes in the accused devices as well as in the device described in the Shields patent (PX-1). Claim 1 does not specify how the period of time between pushes is measured, so that for purposes of Claim 1 this period may be measured by the travel time of the pusher plate, as in the device of the Shields patent (PX-1), just as well as by the time taken for a selected number of boxes to accumulate as measured by an electronic counter as in each of the accused devices.

The file wrapper passage quoted at page 60 of Koppers' Brief is not relevant to Claim 1 since that passage contains an argument presented merely to distinguish "a continuously operated pusher", as recited in Patent Claim 4 from certain prior art. However, arguments related to this point were not presented in connection with Claim 1 at issue in this law suit in that Claim 1 does not contain language that specifies or implies that the pusher is "continuously operated". (See S&S main Brief, pp. 43-44). Thus, the file wrapper did not exclude an "intermittently" operated pusher from the scope of patent Claim 1 herein issue.

(4) The Koppers Slapper Reciprocates in a Linear Direction and Falls Within Claim 1 (Reply to K. Br. p. 61)

The relevant limitation in Claim 1 is:

"One of the said plates abutting the trailing edge of the blanks in the stack and being periodically reciprocally movable in a longitudinal direction to apply a straightening force to the blanks;"

Koppers argues that its plate, or slapper, does not reciprocate in a longitudinal direction, because it is pivoting. However, Koppers cannot deny that the effect of the pivoting motion is to move the portion of the slapper that contacts the blanks in a longitudinal direction and because the slapper is pivoting back and forth, the slapper is reciprocating in that longitudinal direction. With the accused devices, the significant characteristic and movement direction of the slapper is reciprocatory, without regard to movement in other directions.

The president of Plaintiff Universal testified that slapper plates E of S&S' deposition exhibits 2 and 9 corresponding to PX-3 and 5, respectively, are "reciprocating" plates (DX-P, pp. 11 and 43). Further, the Spiess patent (PX-2, Tab 16), shows slapper 150 that is mounted to pivot 151 and is described as a "reciprocating" member (PX-2, Tab 16, col. 5, l. 48). Koppers' Brief fails to cite any authority that meets this issue head-on. Thus, it is submitted that within the context of the suit patent and the prosecution history thereof, the term "reciprocating" to describe the action of the slapper plate fully describes the action of the slapper plate of each accused device.

Koppers suggests that the reciprocation was added to avoid the cited prior art. This is not true, as discussed ante, p. 20.

That the motion of Koppers' slappers may itself be known in the art does not take away from the fact that the S&S entire combination is a novel, unobvious one, nor does it take away from the fact that Koppers' slapper does have reciprocating motion within the meaning of Claim 1.

(5) Koppers' Pusher Plate is Mounted for Limited Vertical Movement in the Manner Required by the Claim (Reply to K. Br. p. 62)

This section of Koppers' Brief virtually repeats a previous section thereof, at pp. 41-44. Rather than again pointing out the deficiencies in Koppers' argument, attention is directed to the present Brief, ante, pp. 17-20.

(6) Koppers Has the Pusher Plate of Its Accused Device Held in a Substantially Vertical Position by Support Means and the Pusher Plate is Mounted for Limited Vertical Movement with Respect to the Means that Supports It, Whereby no Claimed Element is Missing from the Accused Device (Reply to K. Br. p. 63)

This section of Koppers' Brief virtually repeats a previous section thereof, at pp. 45-47. Rather than repeat the same arguments showing why Koppers' position is inadequate, attention is directed ante herein, pp. 17-18.

Koppers' accused devices include a support for the pusher plate and include the relative motion of the pusher plate with respect to its support as recited in the claim. That the Koppers apparatus is not the same as the S&S actual apparatus or as the apparatus disclosed as the preferred embodiment in the specification of the S&S patent does not take away from the fact that the Koppers accused device has the claimed elements, whereby the claim is infringed.

Summary of Arguments Showing Infringement
(Reply to K. Br. p. 65)

Contrary to Koppers' assertion, there is infringement of Claim 1 because there is identity in the structure, function and operational means between the claimed apparatus of the suit patent and Koppers' accused machines.

There was no basis for the finding by the Court below that the Koppers machine included different means than the S&S claim recited. As noted in the passages of the Opinion of the Court below cited at the top of Koppers Brief at p. 66, the reason the Court below was confused as to infringement is that it compared the Koppers' accused device with the S&S actual machine, instead of comparing it with the S&S patent claims. The comparison that the Court did was improper. (S&S main Brief, p. 37) Having made an improper comparison, it is no wonder that the Court below reached an improper conclusion. If the proper comparison of the accused device with the language of the claim had been made, the Court below would have found that the means of the patent claim and the means of the accused device are the same. The Court below committed reversible error.

Furthermore, the Court's holding that the invention in the accused patent is extremely narrow is incorrect, as discussed above.

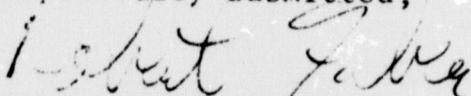
That Koppers used individual structures known in the prior art is irrelevant to both validity and infringement. As was discussed above, any combination will include elements known in the prior art. It is not the elements themselves which rise to the level of patentability. Rather, it is a combination of the known elements that is unobvious and, therefore, patentable. Koppers cited Reiner v.

I. Leon Co., 324 F.2d, 648, 651 (2 Cir. 1963) at pp. 66-67 of its Brief to show that where an article is based on the prior art, infringement is avoided. This is Hornbook law. One cannot infringe if one makes the prior art. But, Koppers did not make the prior art. There is no single prior art reference and no combination of prior art references which Koppers followed. The combination it did follow, SES' patented combination, was an unobvious combination not known in the prior art. The quotation from Reiner, supra, 324, F.2d at p. 649 which appears at p. 67 of Koppers' Brief is almost irrelevant here. The word "disclosures" was used by this Court instead of "claims". However, the context and language of the opinion shows that the Court is discussing the claims of the patent and discussing infringement of the claims, whereby the Court is merely saying that there cannot be infringement if the accused device is markedly different from the claims of the patent in suit.

CONCLUSION

The patent in suit is valid and it is infringed. The judgment of the Court below was in error and should be reversed.

Respectfully submitted,



OSTROLENK, FABER, GERB & SOFFEN
Attorneys for Defendant-Appellant
260 Madison Avenue - 11th Floor
New York, New York 10016
(212) 685-8470

Jerome M. Berliner
Robert C. Faber

AFFIDAVIT OF SERVICE

Re: 74-1496

Koppers Company, Inc. v. S & S Corrugated

STATE OF NEW JERSEY :
: ss.:
COUNTY OF MIDDLESEX :

I, Muriel Mayer, being duly sworn according to law,
and being over the age of 21 upon my oath depose and say
that: I am retained by the attorney for the above named
Defendant-Appellant.

That on the 2nd day of October, 19 74, I served the
within Reply Brief for Defendant-Appellant in the matter of
Koppers Company, Inc. v. S & S Corrugated Paper Machinery,
upon Wyatt, Gerber & Shoup, Esqs., 230 Park Av., New York, N.Y.,
by depositing two (2) true copies of the same securely
enclosed in a post-paid wrapper, in an official depository
maintained by the United States Government.

Muriel Mayer
Muriel Mayer

Sworn to and subscribed
before me this 2nd day
of October 19 74.

Lorraine Leotta
A Notary Public of the
State of New Jersey.
LORRAINE LEOTTA
NOTARY PUBLIC OF NEW JERSEY
My Commission Expires April 13, 1977.

